



22 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Heather Bakalyar  
The John Hopkins University  
3400 N. Charles Street  
Baltimore, MD 21218

In re Application of  
CLARKE, et al.  
Serial No.: 10/530,017  
PCT No.: PCT/US03/31089  
Int. Filing Date: 01 October 2003  
Priority Date: 01 October 2002  
Atty Docket No.: 60022 (71699)  
For: USE OF BIOMARKERS FOR DETECTING  
ACUTE RENAL TRANSPLANT REJECTION

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the "Petition Under 37 CFR §1.47(a)" filed 24 April 2006 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Ernesto Molmenti. Applicant has authorized charging of the \$200.00 petition fee to deposit account number 04-1105.

**BACKGROUND**

On 01 October 2003, applicant filed international application PCT/US03/31089 which claimed priority to a previous application filed 01 October 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 01 April 2005.

On 01 April 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and an application data sheet.

On 22 September 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 24 April 2006, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time. With payment of the five-month extension of time coupled with the fact that 22 April 2006 was a Saturday, applicant's present response is

considered timely filed.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts." The statement of facts from Mr. Peter Corless does not satisfy this item. Mr. Corless states that he has "repeatedly attempted to locate Ernesto Molmenti, but has been unsuccessful in recent attempts. However Mr. Corless does not detail these inquiries nor has applicant included any evidence of what these efforts were. For example, applicant should include the results of any internet or telephone directory searches which were performed in an effort to locate the non-signing inventor. In addition, applicant should include a statement from the individual who made these inquiries.

Regarding item (4), the filed declaration does not comply with 37 CFR 1.497 (a)-(b). Specifically, MPEP Section 201.03 states that:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains three pages "4 of 5." This suggests that either the filed declaration was compiled from numerous declarations or that the inventors only returned their signature pages. Either scenario renders the document non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294  
Fax: 571-273-0459